

10/31/02
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**CERTIFICATE OF FACSIMILE TRANSMISSION**

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By: Elaine Checovich
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To: Examiner
10/31/02
In re Application of :Vulpitta, et al.

For :ANTI-TELESCOPING
ADHESIVE TAPE PRODUCT

Serial No. :09/711,478

Filed :November 13, 2000

Date of Last
Office Action :August 20, 2002

Examiner :Jane J. Rhee

Group Art Unit :1772

Our Docket :MAEE 212957

Assistant Commissioner for Patents
Washington, D. C. 20231

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REQUEST FOR RECONSIDERATION

Dear Sir:

Remarks

The Office Action of August 20, 2002 has been received and carefully studied. The Office Action continues the rejection of all claims in the pending application based upon two references.

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The Claims Are Not Anticipated

Claims 1, 5, 11, 13-14 are rejected as anticipated by Downing. The claims recite an adhesive tape product comprising a hollow cylindrical core, a compressible foam strip surrounding the core and a length tape wound in several turns about the core and the foam strip. In contrast, Downing discloses a tape dispenser in which the central hub of the dispenser (27) referred to in the Downing reference as a vertical wall, is surrounded by a foam body which is in turn surrounded by a tape core upon which a tape is wound. Thus Downing does not anticipate a structure in which a tape core is surrounded by a foam body which is in turn surrounded by several layers of tape. The Office Action states:

"In response to applicant's argument that Downing does not use a foam layer on the outside of the tape core but rather uses foam between the tape core and the wall upon which it rides, the tape core is respectively considered to be number 27 in figure 1 it being the innermost part of the dispenser, therefore, the foam layer as shown in figure 1 number 28 is inbetween the core and the adhesive tape number 13."

It is respectfully submitted that this reading goes against the teachings of Downing and the plain meaning of the word "core" in the area of tape technology.

Downing itself specifically identifies a tape core. It states:

"In accordance with this invention, a ring 28 of frictional material is carried on the vertical wall 27 and engages the inner surface of the core 22 of the roll of tape. (Column 3, lines 56-60)."

Downing states elsewhere:

"The adhesive tape and the carrier web are wound into a roll-form and carried on a core 22. (Column 3, lines 44-45)."

Thus Downing refers to the hollow cylindrical element upon which the tape is wound and

with which it rotates as the core. Other references cited in this application use "core" in an identical manner. Thus, DeCoste 4,907,696 describes collapsible core adhesive rolls. The hollow cylinders upon which the tape is wound are called cores. Sinn, et al. 5,755,905 also describes pressure sensitive adhesive tape rolls. It describes an element 26 which is a hollow cylindrical tape core upon which the tape is wound. Spatorico 6,077,577 also describes a pressure sensitive tape product. The thing upon which the tape is wound is called a core.

Submitted herewith is a web page describing 3M Scotch tape dispensers. The dispensers are described as accommodating either one inch core tape or three inch core tape. The dispenser consists of a base, a hub and a cutter. The tape upon the core is carried on the hub in the base. Thus, the center most element of the dispenser is a hub but the element which carries the tape and rotates with it is called the "core." Another page from the 3M web site describes a particular kind of tape offered by 3M as "available in a variety of lengths, widths and core sizes."

The word "core" is so uniformly recognized as having a specific meaning with respect to tapes, that it is a defined term under ASTM standards. Submitted herewith is a portion of ASTM Standard D996-99 entitled "Standard Terminology of Packaging in Distribution Environments". The word "core" is defined as a noun "in packaging, a cylindrical structure used as a carrier of flexible material that is wound around it." This definition is used in ASTM Standard D3715 entitled "Standard Practice for Quality Assurance of Pressure-Sensitive Tapes". In section 5.3.2.1 Major Defects the following paragraph is set forth "cores" "inside diameter less than 7 6.2 millimeters [3 in.] or more than 79.4 mm [3 1/6 in.] or not other specified dimension. Core crushed, broken, mutilated or collapsed." In section 5.3.2.2 Intermediate Defects, the following is set forth "core"

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"identification markings omitted, incorrect, incomplete, illegible, or not as specified." In section 5.3.2.3 Minor Defects, for "tape on rolls," the Standard says "Rolls not evenly and uniformly wound; not wound on either paper fiber or plastic core; core not same width as tape." Thus ASTM standards reflect the same meaning seen in the patent references: core means the hollow cylinder upon which the tape is wound and with which it rotates.

In sum, the word "core" is used in the patent literature, industry literature, industry standards and elsewhere to describe the element (often a hollow cylinder) upon which a body of pressure sensitive tape is wound in several layers to form an adhesive tape product. This product may be placed upon a dispenser having a hub. Whether on a dispenser or not, the element upon which the tape is wound and with which it rotates is called the core. The dispenser hub, even when positioned inside this core, is not called the core.

It is respectfully submitted that the reading being placed upon the Downing reference is inconsistent with the Downing reference itself and with the everyday meaning of the word "core" to the industry and hence to the person of ordinary skill in the art. The claims are not anticipated.

Martin-Cocher Is Not Analogous

The Office Action dismisses applicants' assertion that Martin-Cocher is not analogous art stating that in order for art to be analogous it "must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned." The Action then asserts "in this case, the prior reference is reasonably pertinent to applicant's endeavor wherein a material is wrapped around a spool or core and dispensed therefrom."

Applicants respectfully traverse.

All of applicants' claims begin "an adhesive tape product". The title of the application is "ANTI-TELESCOPING ADHESIVE TAPE PRODUCT". Applicants' specification describes adhesive tape products and the problems associated with them. Thus, the field of applicants' endeavor is adhesive tape products. Martin-Cocher is not concerned with an adhesive tape product. Rather, it is describing a non-adhesive product, a stretch film, to be used in industrial packaging applications such as pallet wrapping. The film is stretched different amounts in different zones across its width and is wide. Applicant is dealing with an adhesive coated tape which is from one half inch to two inches wide. Long narrow adhesive tape for use by consumers is not the same field of endeavor as industrial wrapping of pallets or products for shipment.

The other half of the test set forth in the Office Action with reference to In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) is whether the reference is reasonably pertinent to the particular problem with which the applicant was concerned. Applicants are concerned with telescoping in rolls of adhesive tape. This is stated in the title of the invention and made clear throughout the specification. The reference makes no suggestion with respect to this problem and is not at all pertinent with respect to the problem as it is not dealing with long narrow tapes wound upon a core.

It is respectfully submitted that Martin-Cocher is not analogous art under the test set forth in the Office Action.

Numerous Federal Circuit cases support the distinction made above. In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985) it was held that references are within the pertinent art only if they are pertinent to the problems confronting the

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inventor in the particular application. In King Instrument Corp. v. Otari Corp., 767 F.2d 854, 226 USPQ 402 (Fed. Cir. 1985) cert. denied 475 U.S. 1016 (1986) it was held that a patent for splicing photo typographic film in the printing industry was not within the inventor's field of endeavor or pertinent to his problem with respect to a patent for splicing and winding magnetic tape into a cassette. While both were concerned with tapes, the problems encountered were very much different. The reference dealt with film that was 4 to 6 inches wide while the patent at issued concerned long narrow audio tape. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986) restated the two step test discussed above. Prior art is analogous only if the reference is "within the field of the inventor's endeavor" or is "reasonably pertinent to the particular problem with which the inventor was involved." Here, neither test is met. It is submitted that Martin-Cocher is not analogous art and is not a proper reference.

Downing And Martin-Cocher Do Not Teach A Combination

The Office Action next asserts that it was appropriate to combine the two references because "Martin-Cocher et al. teaches a general concept wherein a film material is wrapped around a barrel shaped spool in order to accommodate the elongation of the film." Martin-Cocher stretches a film different amounts in zones across its width. Applicants do not perform this differential stretching. Applicants are dealing with an unstretched tape, not a film of appreciable width stretched different amounts across its width. Thus, Martin-Cocher is dealing with something fundamentally different from the field of endeavor of applicant and its teaching has no pertinence. Applicant uses a barrel shaped core for a narrow long tape product to address the telescoping problem. Martin-Cocher teaches nothing regarding this. Downing teaches nothing regarding this. It is therefore not taught

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to combine Martin-Cocher with anything pertinent to applicants' invention.

Summary

Neither of the references teaches positioning a foam between the tape core and the body of tape itself in an adhesive tape product. Therefore, claims 1, 11, 14 and all the claims that depend from these claims are not properly rejected. Nothing in the references teaches using a barrel shaped core under several turns of adhesive tape to prevent telescoping in an adhesive tape product. Therefore claim 7 and the claims that depend from claim 7 are not properly rejected. Martin-Cocher is not a proper reference for use in rejecting claim 7 and Martin-Cocher is not properly combined with the primary reference, Downing.

It is respectfully submitted that under the standard set forth in the case law cited above, that claims 1-15 are allowable.

Respectfully submitted,

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